

The Examiner has stated that it is argued that page 1 of the previously submitted Exhibit 1 shows conception on or before 8/31/2000. However, the document itself is clearly more recent because there are newer versions listed and because said page 1 also includes a "last modified" date of 9/12/2000. Further, the document "One-Click Details" forming part of the previously submitted Exhibit 2 is dated 9/14/2000 - also after the effective date of Chamberlain.

MPEP 715.07 II. ESTABLISHMENT OF DATES : "If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration."

The declaration therefore requires the evidence required by the Examiner. Applicants again point out that the Exhibits 1, and 2 merely serves as supporting evidence of the declaration. In the declaration, in paragraph 5, the statement has been made that the date of invention is prior to the date of Chamberlain. The date of the document is not relevant: what is relevant is the date of invention.

MPEP 715.07 I GENERAL REQUIREMENTS: "However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)."

Applicants, accordingly, respectfully request withdrawal of this objection based on the date of the Exhibits 1 and 2.

The Examiner states that there is no explanation regarding which portions of the evidence relates to each and every claim feature of all claims.

Firstly, MPEP 715.07, under I GENERAL REQUIREMENTS quoted above specifically states that an accompanying exhibit need not support all claims limitations,

provided that any missing limitation is supported by the declaration itself. In the declaration, paragraph 6, a detailed comparison has been given as to how claim 1 relates to Exhibit 2 and the declaration. Any elements that may be missing from the Exhibits 1 and 2 are supported by the declaration itself. Furthermore, the figure on page 3 of Exhibit 1 is in material substance identical to Figure 3 of the present application.

Because the claim is based on Figure 3 of the present application, and Figure 3 of the present application is in material substance identical to the figure on page 3 of Exhibit 1, the claim should therefore also be supported by the figure on page 3 of Exhibit 1.

Applicants therefore submit that each and every element of claim 1 is supported by the figure on page 3 of Exhibit 1. Applicants have proven that each and every element of claim 1 is supported by Exhibit 1, although there is no requirement for Applicants to prove that each and every element is supported by Exhibit 1.

Furthermore, the Examiner's contention that the evidence should be provided for all the claims is not supported by any rule or law. What is required is prior invention. The invention is represented in independent claim 1. If independent claim 1 has a date of invention prior to the reference then each and every claim depending from claim 1 also has a date of invention prior to the reference. Applicants therefore also request withdrawal of this rejection because it is not supported by any rule or law and it is contrary to established patent practice.

Applicants therefore request withdrawal of the rejection that there is no explanation regarding which portions of this evidence relates to each and every claimed feature of all claims.

2. The Examiner states that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Chamberlain reference. Applicants submit that the reasons given above are sufficient to overcome this rejection and respectfully requests withdrawal thereof.
3. The Examiner states that there is no evidence of diligence between 9/8/2000 and 9/19/2000. 9/8/2000 was on a Friday and 9/19/2000 was on a Tuesday, such that there were a total of only six business days between the two dates. Six business days is a very short period of time. Clearly the Examiner cannot expect that diligence be demonstrated for every single day. Applicants submit that the diligence demonstrated on 9/19/2000 is sufficient to demonstrate diligence for the entire six working days between 9/8/2000 and 9/19/2000. As the Examiner will recognize it can take weeks and months to prepare and file a patent application.
4. Applicants state that Daniel Fossner is not an inventor.

35 U.S.C. §§ 102 and 103 Rejections

Rejections of claims 1-10, 12, 17, 19, 20 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, 35 U.S.C. § 103(a) as obvious over Chamberlain, (U.S Patent Publication No.: 2003/208369, hereinafter “Chamberlain”).

The Examiner has rejected claims 1-10, 12, 17, 19, 20 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, 35 U.S.C. § 103(a) as obvious over Chamberlain.

As pointed out in the last Response, Applicants have submitted herewith a declaration by F. William Daugherty under 37 C.F.R. 1.131. Specifically, the declaration states that the date of invention of the present patent application is before the effective date of Chamberlain. The declaration also states that the Applicants were diligent from the effective date of Chamberlain until the constructive reduction to practice by filing a provisional patent application. Applicants respectfully request that the Examiner accepts the declaration into evidence to remove the Chamberlain reference as prior art.

Applicants, accordingly, respectfully request withdrawal of the rejections of claims 1-10, 12, 17, 19, 20 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, 35 U.S.C. § 103(a) as obvious over Chamberlain.

Rejections of claims 11 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Chamberlain in view of Patterson, (U.S Patent Publication No.: 2003/0028608, hereinafter “Patterson”).

The Examiner has rejected claims 11 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Chamberlain in view of Patterson, (U.S Patent Publication No.: 2003/0028608, hereinafter “Patterson”).

Chamberlain does not constitute prior art, as discussed under the previous heading. In addition, claims 11, 13-16 depend from independent claim 1 and should therefore be allowable for at least the same reasons as claim 1.

Applicants, accordingly, respectfully request withdrawal of the rejections of claims 11, 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Chamberlain in view of Patterson.

Rejections of claims 1-10, 12, 17, 19, 20 under 35 U.S.C. § 103(a) as being unpatentable over Strandberg, (U.S Patent No.: 6,333,243, hereinafter “Strandberg”).

The Examiner has rejected claims 1-10, 12, 17, 19, 20 under 35 U.S.C. § 103(a) as being unpatentable over Strandberg. Applicants submit that these claims are patentable over Strandberg.

Strandberg Not Relevant

The claims rejected by the Examiner are related to advertisements that are served on a World Wide Web site and user selectable options for further information. Strandberg, by contrast, does not appear to related to advertisements. For example, column 5, lines 7 to 15, referred to by the Examiner, state as follows:

“One example of the information provider server 114 includes a computer, generating data to create a Web-page. The second data server 114 transmits the data across the datapath 116, such as the Internet-World Wide Web to the first data server 112 and to the data terminal 10. The data terminal 10 responds to the data sent by the data server 114 and displays a user interface based on this data. This data is typically a Hyper

Text Markup Language (HTML) file that is interpreted by the data terminal 10.”

What the above section relates to is nothing more than regular Internet communication utilizing HTML.

The Examiner has also referred to column 5, lines 24-31, which state as follows:

“The data entry fields are designed to elicit responses to requests for information from the inquiring parties, as is well known in the art. Such requests can include the inquiring party's name, telephone number, address, account information, the information the inquiring party desires, inquiries into particular products or services, or any other information useful for sales and/or marketing purposes.”

This section appears to relate to regular Internet standard for fillable fields. This section therefore thus does not relate to advertisements and user selectable options for providing associated information.

In Strandberg, column 3, lines 28-36 state as follows:

"The present invention features an electronic chat session distribution system 100, FIG. 1, for providing a real-time electronic chat session between an inquiring party and at least one agent at the request of the inquiring party, who enters an electronic chat session request at a data terminal 10. The data terminal 10 which is located at a first location, such as a user's residence, place of business, or public location (e.g., a mall), is used for entering and transmitting data over a first data path 14."

What this section states is that Strandberg relates to chat sessions. Chat sessions such as provided by Internet Relay Chat (IRC) (See column 2, lines 22-23) requires different communication techniques than the present invention. Applicants therefore submit, with respect, that Strandberg's chat sessions are not relevant for the present invention that relates to serving of an advertisement and receiving a user selection for further information, and that one of ordinary skill in the art would not look to Strandberg for purposes of the invention as claimed.

In summary, therefore, Stranberg is not relevant for an obviousness determination of the present invention because the Examiner has not established that Strandberg relates to anything more than HTML Internet communication, data entry, and chat session communications while the present invention relates to advertisements that are served on a World Wide Web site and user selectable options for further information.

Strandberg fails to disclose at least one element of claim 1

The Examiner states as follows:

"Each of the plural fillable fields of Strandberg's interface is taken to represent a "selectable" option"

It appears that the Examiner is equating the entry of data in a field by a user in Strandberg to selection of an option for information delivery. Strandberg does not disclose an extra step of collecting user information. As such, Strandberg discloses either selection of an option or collection of user information, not both.

Referring to Figure 3 of the present application, it can be seen that a user selection is received following the 12 and, as a separate process, user information is received at 332. The personalized email sent at 352 utilizes the user information received at 332 and is due to selection made by the user at 312.

Claim 1 now includes two separate operations, one for receiving user information associated with a selectable option, and another for receiving an indication of a user selection of one of a plurality of selectable options. There are thus two processes in claim 1. Claim 1 thus includes at least one limitation that is not suggested by Strandberg. (It should be noted that a method claim is not limited to the sequence of steps claimed, absent evidence to the contrary)

Claim 1 can therefore not be obvious in view of Strandberg because Strandberg fails to disclose or suggest at least one process in claim 1. Claims 2-10, 12 depend from claim 1 and should be allowable for at least the same reasons as claim 1. Claim 17 has been amended to have limitations that are similar to the limitations of claim 1. Claim 19 and 20 depend from claim 17 and should be allowable for at least the same reasons as claim 17.

Impermissible Hindsight

In 1989, whilst working at CERN, Tim Berners-Lee invented a network-based implementation of the hypertext concept. A potential turning point for the World Wide Web began with the introduction of the Mosaic web browser in 1993, a graphic browser

developed by a team at the National Center for Supercomputing Applications at the University of Illinois at Urbana Campaign, led by Marc Andreessen. As noted in the attached declaration of Daniel Fossner, the present invention was conceived on or before August 31, 2000, roughly seven years after the introduction of the Mosaic web browser. The Strandberg reference was first cited in an Office Action on August 23, 2007, roughly an additional seven years after the date of invention. Therefore, no Examiner at the United States Patent and Trademark Office believed that one of ordinary skill in the art would rely on the Strandberg reference to render the present invention for a time period that was an additional 100% the life of the graphic Internet as measured from the introduction of the Mosaic web browser up to the date of invention. The Examining Division's own reluctance to rely on Strandberg for an extended period of time thus serves as evidence that the present invention is not obvious over Strandberg. The Examiner's reliance on Strandberg on August 23, 2007 is excessively based on twenty-twenty hindsight and is based on the Examiner's knowledge of the state of the art in 2007.

The Examiner's position that the present invention is obvious over Strandberg has grown stronger in recent years up to the Office Action dated January 12, 2009. It therefore appears that the Examiner is relying even more heavily on twenty-twenty hindsight in the Examiner's belief that the invention is obvious as time goes by.

35 U.S.C. § 103(a) states as follows:

"...though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." (Emphasis added)

Applicants submit that the Examiner is relying on impermissible hindsight in the Examiner's belief that the invention is obvious because the Examiner is relying on the Examiner's own knowledge at the date of an Office Action instead of the time that the invention was made, and that the Examiner's position is being impermissibly exacerbated as time goes by. Applicants submit that the Examiner's rejections of the claims based on Strandberg are improper.

For these reasons, Applicants respectfully request withdrawal of the rejections of claims 1-10, 12, 17, 19, 20 under 35 U.S.C. § 103(a) as being unpatentable over Strandberg.

The Examiner also rejected claims 11, 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Stranberg in view of Patterson. These claims depend from claim 1 and should be allowable for at least the same reasons as claim 1. Applicants, accordingly, respectfully request withdrawal of the rejections of claims 11, 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Strandberg.

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen M. De Klerk at (650) 798-0342.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHN NATH & ROSENTHAL LLP

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